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FISH & RICHARDSON P.C.
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

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HARRELL, ROBERT B	

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BARRY APPELMAN, LARRY L. LU,
and JIAN WANG

Appeal 2009-0633
Application 09/842,024[1]
Technology Center 2400

Decided:[2] April 6, 2009

Before HOWARD B. BLANKENSHIP, JAY P. LUCAS, and THU A. DANG, *Administrative Patent Judges*.

LUCAS, *Administrative Patent Judge*.

DECISION ON APPEAL

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[1] Application filed April 26, 2001. Appellants claim the benefit under 35 U.S.C. § 119 of provisional application 60/236,351, filed 09/29/00. The real party in interest is AOL LLC.

[2] The two month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

Appellants appeal from a final rejection of claims 1, 2, 4 to 11, and 15 to 20 under authority of 35 U.S.C. § 134(a). The Board of Patent Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b). An Oral hearing was held on March 18, 2009. Claims 3 and 12 to 14 are cancelled.

Appellants' invention relates to a method, apparatus and program for transmitting data to one or more targeted on-line users of a communications system. In the words of the Appellants:

> A method for transmitting data to one or more users of a communications system by establishing a connection with one or more users; designating targeting rules applicable to online users; acquiring context information of online users; applying the targeting rules to the context information to identify targeted online users; and sending data to the targeted online users.

(Abst., Spec:26.)

Claim 1 is exemplary:

1. A method for transmitting data to one or more online users of a communications system, the method comprising:

establishing a connection with one or more online users;

designating targeting rules applicable to the one or more online users, the targeting rules designating at least a target geographic location and at least one of a target type of access device or a target type of software;

acquiring context information of the one or more online users, the context information indicating at least geographic locations of the one or

more online users and at least one of a client type of access device employed by the one or more online users or a client type of software employed by the one or more online users;

applying the targeting rules to the context information to identify a subset of the one or more online users that are associated with the target geographic location and who employ at least one of the target type of access device or the target type of software;

generating a message that contains geographic information describing conditions in at least a portion of the target geographic location; and

sending the message to the identified subset of the one or more online users.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Burfeind	US 6,360,172 B1	Mar. 19, 2002 (filed Aug. 13, 1999)

REJECTION

The Examiner rejects the claims as follows:

R1: Claims 1, 2, 4 to 11, and 15 to 20 stand rejected under 35 U.S.C. § 102(e) for being anticipated by Burfeind.

Groups of Claims:

Arguments will be considered in the order of their presentation, and applied to the rejection of all claims except as indicated. Claim 1 is representative.

Appellants contend that the claimed subject matter is not anticipated by Burfeind for failure of that reference to teach key claim limitations. The Examiner contends that each of claims is properly rejected.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Briefs and the Answer for their respective details. Only those arguments actually made by Appellants have been considered in this opinion. Arguments which Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived.

We affirm the rejections.

ISSUE

The issue is whether Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 102(e). The issue turns on whether Burfeind teaches the targeting rules to identify sets of online users as claimed.

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. Appellants have invented a method for transmitting information to a selected one or more online users to provide targeted information related to the location of the users. (Spec. 18, l. 6). The information may be customized to the user's type of access device or software. (Spec. 19, l. 1).

2. Burfeind teaches sending weather data to an online user with information specific to his location and device. (Col. 10, l. 50; col. 11, l. 15).

PRINCIPLES OF LAW

"In reviewing the [E]xaminer's decision on appeal, the Board must necessarily weigh all of the evidence and argument." *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

In rejecting claims under 35 U.S.C. § 102, "[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation." *Perricone v. Medicis Pharm. Corp.,* 432 F.3d 1368, 1375-76 (Fed. Cir. 2005) (citation omitted).

"Anticipation of a patent claim requires a finding that the claim at issue 'reads on' a prior art reference." *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346 (Fed. Cir. 1999).

However, although elements must be arranged as required by the claim, "this is not an '*ipsissimis verbis*' test," i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990).

ANALYSIS

From our review of the administrative record, we find that Examiner has presented a prima facie case for the rejection of Appellants' claims under 35 U.S.C. § 102. The prima facie case is presented on pages 3 to 4 of the Examiner's Answer. In opposition, Appellants present a number of arguments.

Arguments with respect to the rejection of representative claim 1 under 35 U.S.C. § 102(e) [R1]

Appellants contends that Examiner erred in rejecting claims 1, 2, 4 to 11, and 15 to 20 under 35 U.S.C. § 102(e). Appellants contend that

> Burfeind still fails to describe or suggest applying the targeting rules to the context information to identify a subset of one or more online users, as recited in claim 1….
>
> Instead, as clearly shown and described with respect to FIG. 4 of Burfeind, Burfeind's system first identifies a user, accesses personal preferences for the identified user, and subsequently generates a message based on the personal preferences of the identified user.

(App. Br. 5:bottom)

The Burfeind patent describes a system for distributing information (e.g., weather data) to users through various multimedia output devices, for example on-line computers. (Col. 11, ll. 10–25). The users request the weather information, and based on information stored about the requesting user, his location and his device in a preference file, combined with information from radar, satellites and other sources, a customized report is delivered to the user. (Col. 10, ll. 44-66).

Appellants argue that Burfeind does not teach the claimed targeting rules. However, according to the claims, the targeting rules are "applicable to one or more online users" providing "geographic location and at least one of a target type of access device or a target type of software," per claim 1. [emphasis added]. The personal preference database 426 of Burfeind provides information applicable to the one requesting user, including his geographic location (e.g., Miami- col. 11, l. 17) and his access device (e.g., PDA – col. 10, l. 60). Thus, the targeting rules identify the one requesting user associated with the geographic location and employing the targeted type of access device.

Arguments with respect to the rejection of claim 4 under 35 U.S.C. § 102(e) [R1]

With respect to dependent claims 4 and 11, Appellants further argue that Burfeind fails to teach "the targeting rules additionally designate an online location and applying the targeting rules" to the users visiting the

online location. (App. Br., 7:middle). In view of Burfeind's numerous recitation of online users (e.g., col. 3, l. 20; col. 5, ll. 15 to 26) and geographic locations (col. 10, l. 17), we do not find this argument persuasive.

Appellants further argue that Burfeind fails to teach ranking the online users based on parameters. (App. Br. 7: bottom). Burfeind teaches the refinement of user activities ranked at different levels of specificity: base activities, and the more refined travel, interest, and occupation activities. (Col. 14, ll. 47– 60). We find this a sufficient teaching of ranking the users as in claim 11.

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that the Examiner did not err in rejecting claims 1, 2, 4 to 11, and 15 to 20 under 35 U.S.C. § 102 [R1].

DECISION

The Examiner's rejection of claims 1, 2, 4 to 11, and 15 to 20 is Affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

rwk

FISH & RICHARDSON P.C.
P.O. BOX 1022
MINNEAPOLIS MN 55440-1022